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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUG DOHRING, WILLIAM MCCAFFREY,
STEPHANIE YOST, DAVID HENDRY, and LEE BORTH

Appeal 2016-007843
Application 12/946,538
Technology Center 3700

Before: CHARLES N. GREENHUT, MICHELLE R. OSINSKI and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–5, 7–62, and 64–67. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to an online immersive and interactive educational system. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An online immersive and interactive computer-based educational system for children aged about 1 to about 10 years, comprising:
 - (a) a digital processing device that is connected to the Internet comprising an operating system configured to perform executable instructions and a memory device;
 - (b) visual and audio content provided to the digital processing device via the Internet, and at least partially stored in the memory of the digital processing device, that creates an immersive and interactive computer-based educational environment for a child aged about 1 to about 10 years, wherein the computer-based educational environment is further characterized by comprising:
 - i. at least three subjects available to the child, within the computer-based educational environment, wherein each subject comprises a plurality of levels of learning;
 - ii. a plurality of computer-based activities associated with each subject; wherein the plurality of computer-based activities teaches toward one or more educational objectives in a subject; wherein the plurality of computer-based activities consists essentially of activities teaching toward one or more educational objectives in a subject; wherein the plurality of computer-based activities associated with each subject includes a book and at least one additional activity; wherein one or more of the plurality of computer-based activities comprises a plurality of skill levels and wherein a mentor to the child, the child, or the computer-based educational system selects a skill level appropriate for the child, wherein the computer-based educational system automatically selects a skill level appropriate for the child based on one or more of: age, performance in previously completed activities, and the number of times the child has completed the

activity, the skill level related to the difficulty of the activity and the actions required to complete the activity;
iii. a software module for monitoring the progress of the child in each of the subjects;
iv. a software module for rewarding the child for completing an activity; and
v. a software module for creating an avatar to represent the child; provided that the computer-based educational environment, the subjects within the computer-based educational environment, and the plurality of computer-based activities are suitable for the child aged about 1 to about 10 years with regard to educational objective, content, interface, and difficulty.

REJECTIONS

Claims 1–5, 7–62, and 64–67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

OPINION

The claims are argued as a group for which we select claim 1 as representative under 37 C.F.R. § 41.37(c)(1)(iv). We agree with and adopt as our own the Examiner’s analysis of claim 1. *See* Final Act. 3–4; Ans. 6–10. We add the following discussion for emphasis.

Initially, Appellants analogize their claims to, *inter alia*, those held eligible in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), asserting that “the pending claims recite a specific technological solution.” App. Br. 11; Reply. Br 6–9. However, in making this argument Appellants do not direct our attention to any specific claim language that describes the purported *specific* technological solution. Appellants identify the problem as “how to engage and retain particular website visitors.” App. Br. 11. “[C]reat[ing] ‘an immersive and interactive computer-based

educational environment”” certainly is not a *specific* solution to that problem. The generic components of that environment, i) subjects, ii) educational activities of various skill levels, iii) progress monitoring, iv) rewards, and v) an avatar, cannot reasonably be said to create a *specific* solution so as to remove the claimed subject matter from the realm of the abstract. *See* Reply. Br. 6 (“This is realized through specific unconventional elements that recite specific features for creating an avatar of the child, monitoring the child’s progress, and rewarding the child”). The “immersive and interactive computer-based educational environment” is defined by a series of broad generic goals common to most educational systems. Appellants do not identify, and we are not apprised of any claim language, confining the claimed subject matter to a specific and non-abstract solution.

Appellants next argue the absence of preemption. App. Br. 11–15; Reply Br. 10–11. The Examiner does not discuss preemption at length. Ans. 8–9. Nevertheless, we cannot agree with Appellants that claim 1 does not have a preemptive effect, foreclosing basic tools of teaching.

In *Gottschalk v. Benson*, (409 U.S. 63, 67 (1972)), the Court, citing *O’Reilly v. Morse* (56 U.S. 62 (1853)), cautioned that a claim “so abstract and sweeping as to cover both known and unknown uses” is not directed to patent-eligible subject matter under 35 U.S.C. § 101. *Gottschalk v. Benson*, 409 US at 68. In *Alice Corp. v. CLS Bank Int’l* (134 S. Ct. 2347, 2354 (2014)), the Supreme Court reaffirmed this principle:

We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable. We have interpreted § 101 and its predecessors in light of this exception for more than 150 years.

We have described the concern that drives this exclusionary principle as one of pre-emption. Laws of nature, natural

phenomena, and abstract ideas are the basic tools of scientific and technological work. [M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it, thereby thwarting the primary object of the patent laws. We have repeatedly emphasized this concern that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity.

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. at 2354 (quotations and citations omitted).

In arguing the absence of preemption, Appellants reiterate the five limitations summarized above, without delving into each one specifically, and summarily conclude there is sufficient particularity so as to avoid a preemptive effect. App. Br. 13. This is certainly untrue of limitations iii–v. Limitation iii recites, “a software module for monitoring the progress of the child in each of the subjects.” Clearly, progress monitoring is a fundamental teaching tool. Appellants, with this limitation, in effect, seek to preclude the use of any conceivable “software module,”¹ known or unknown, that monitors a child’s progress in any conceivable way. The breadth of limitation iii would impede innovation in both software and teaching. The same is true of limitations iv and v. Clearly rewards are a fundamental teaching tool. An “avatar,” in computing, is some icon or figure representing a person. This can be simply a computer-based version of a name or picture in a record book or wall chart used to track a student’s

¹ Appellants make no assertion that the term “module” is sufficiently similar to “means” so as to invoke 35 U.S.C. § 112, sixth paragraph. Thus, we do not analyze the claims under § 112, paragraph six. *See, e.g., In Re Avid Identification Systems, Inc.*, 504 Fed. App’x. 885 (Fed. Cir. 2013) (nonprecedential) (arguments that claims limitations should be construed as means-plus-function limitations under 35 U.S.C. § 112, paragraph six, may be waived)

progress. These are also fundamental teaching tools. Limitations iv and v would impede any and all developments in software or teaching methodologies that provide a reward, or create an avatar, for a student. We recognize the language “software module” in limitations iii–v could be argued to limit the preemptive effect on teaching itself. But it cannot reasonably be argued that “software” is not such a common tool in a teaching environment in the current state-of-the-art that the monopolization of all software-based systems and methods directed to achieving the goals enumerated in limitations iii–v would lack a preemptive effect.

We will not analyze all aspects of limitation ii as Appellants have declined to do. *See* 37 C.F.R. § 41.37(c)(1)(iv)(“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. . . . [A]ny arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal”). However, we note this limitation suffers from the same flaws as those of the limitations discussed above. It recites broad and abstract goals, without limitation to the specific structures, steps or algorithms employed for achieving those goals. For example, the language, “wherein the plurality of computer-based activities teaches toward one or more educational objectives in a subject [and] consists essentially of activities teaching toward one or more educational objectives in a subject” covers the use of any known or unknown computer-based activity, used to teach by any known or unknown methodology, any conceivable objective in any conceivable subject. The “consists essentially of” language only precludes the presence of non-educational activities in the teaching environment. Restricting non-educational activities is also a fundamental tool that may be used by an educator. Allowing patent protection for claims containing such broad

abstract language would lead to the effective monopolization of fundamental teaching techniques when used in a computer environment and inhibit, rather than promote, progress in the teaching and computer arts. This runs counter to the objectives of our patent laws.

A limitation recited with particularity in claim 1, subparagraph i, is the number of “subjects available to the child:” “at least three.” However, this is one of several generic and conventional recitations, such as “computer-based”; “digital processing device”; “Internet”; “memory”; “visual and audio content” that does not transform patent-ineligible subject matter into patent-eligible subject matter. *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. at 2358–59 (Generic recitations “cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”). Thus, we agree with the Examiner that claim 1 lacks “significantly more” so as to be directed to non-abstract subject matter. Ans. 9–10. Appellants quote several limitations from claim 1 without any explanation or analysis as to how or why they are directed to subject matter neither generic nor conventional. App. Br. 15–16. The basis for Appellants’ argument in this regard is the absence, or withdrawal, of a prior-art rejection on claim 1. We reject Appellants’ contention that the absence of a rejection under §§ 102 or 103(a) provides evidence that the claimed subject matter is neither generic nor conventional. App. Br. 16–20. The avoidance of piecemeal examination is merely a preferential examination practice. *See* MPEP § 707.07(g). How an Examiner chooses to allocate time and resources is ultimately a procedural matter within the Examiner’s discretion. The absence of a prior-art rejection does not create any binding legal effect for purposes of an analysis under § 101. Appellants have elected not to identify with specificity what particular aspects of the claimed subject matter could be considered non-generic and

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non-conventional or what specific solution creates an improvement in the field. App. Br. 16–20. Claim 1 appears to be nothing more than the application of conventional teaching methodologies to a computer-based environment. We agree with the Examiner’s analysis that this subject matter is not eligible for patent protection under 35 U.S.C. § 101.

DECISION

The Examiner’s rejection is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED